

RECEIVED
CENTRAL FAX CENTER

001/023

SEP 24 2004

PTO/SB/97 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the
United States Patent and Trademark Office

on 9/24/04
Date

Patti Hespell
Signature

Patti Hespell
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

- 1.) Certificate of Transmission (1 pg.)
- 2.) Amendment (18 pgs.)
- 3.) Transmittal Form (1 pg.)
- 4.) Petition for Extension of Time (1 pg.)
- 5.) Fee Transmittal in duplicate (2 pgs.)

Burden Hour Statement: This form is estimated to take 0.03 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

T723-00

1

missing 17 pgs

SEP 24 2004

download server, or a plurality of EPG screens having different targeted advertisements. The Examiner relies on *Macrae* for disclosing these features (paragraphs 218, 219 and 281). The Applicant submits that even assuming arguendo that there was motivation to combine the references (without acknowledging or conceding such) that the combination would not result in the embodiment recited in claim 5.

The Examiner does not rely on *Macrae* for disclosing the features noted above with respect to claim 1 that were absent from the teachings of the Examiner's combination (e.g., an EPG correlation module to select suitable advertisements for insertion in the EPG) and the Applicant submits that *Macrae* does not disclose these features of claim 1. Furthermore, the Applicant submits that *Macrae* does not disclose the additional features of claim 5 (e.g., a plurality of EPG screens having different targeted ads) as suggested by the Examiner. Rather, *Macrae* discloses delivering different ads in different portions of the EPG (one ad in a sports theme grid and a second ad in main menu grid, see para. 281). The ads in *Macrae* are targeted to the EPG screen viewed as opposed to the subscriber (no correlation of ad to subscriber) as recited in independent claim 1 and dependent claim 5.

For at least the reasons noted above, it is submitted that claim 5 is patentable over the cited references. Claims 6-8 depend from claim 5 and are therefore submitted to be patentable over the cited references for at least the reasons advanced with respect to claim 5 and for the further features recited therein. Applicant respectfully submits that the rejection has been overcome and should accordingly be withdrawn and claims 5-8 should proceed to allowance.

Independent claim 22 is directed to a method for delivering targeted advertisements in an electronic program guide (EPG). The method includes characterizing one or more subscribers receiving the EPG. One or more advertisements to be transmitted to the subscribers within the EPG is characterized. The subscribers and the advertisements are correlated based on the subscriber characterizations and the advertisement characterizations. A plurality of EPGs having different targeted advertisements are created based on said correlating.

Initially it is pointed out that the Applicant amended claim 22 to clarify that the EPG screens created have different targeted ads based on the correlation between the subscribers and

the advertisements. The Examiner rejected claim 22 for the same reasons as noted above with respect to claim 5. The Applicant submits that claim 22 is patentable over the combination of references relied on by the Examiner for at least reasons similar to those advanced above with respect to claim 5. For example, even assuming arguendo that the references could be combine there is no combination of the cited references that disclose or suggest correlating subscribers and advertisements in order to find targeted advertisements for the subscribers and then generating multiple EPG screens having different targeted advertisements therein, as recited in claim 22.

For at least the reasons noted above, it is submitted that claim 22 is patentable over the cited references. Claims 23-36 depend from claim 22 and are therefore submitted to be patentable over the cited references for at least the reasons advanced with respect to claim 22 and for the further features recited therein. Applicant respectfully submits that the rejection has been overcome and should accordingly be withdrawn and claims 22-36 should proceed to allowance.

Independent claim 37 is directed to a method for delivering targeted advertisements in an electronic program guide (EPG). The method includes creating a plurality of EPG screens having different advertisements. One or more subscribers receiving the EPG are characterized. The EPGs and the subscribers are correlated based on the subscriber characterization.

The Examiner rejected claim 37 for the same reasons as noted above with respect to claims 5 and 22. The Applicant submits that claim 37 is patentable over the combination of references relied on by the Examiner for at least reasons similar to those advanced above with respect to claims 5 and 22. For example, even assuming arguendo that the references could be combine there is no combination of the cited references that disclose or suggest correlating subscribers and EPG screens having different advertisements, as recited in claim 37.

For at least the reasons noted above, it is submitted that claim 37 is patentable over the cited references. Claims 38-49 depend from claim 37 and are therefore submitted to be patentable over the cited references for at least the reasons advanced with respect to claim 37 and for the further features recited therein. Applicant respectfully submits that the rejection has been overcome and should accordingly be withdrawn and claims 37-49 should proceed to allowance.

Newly added independent claim 50 is directed to a method for delivering targeted advertisements to subscribers of a content delivery network within an electronic program guide (EPG). The method includes characterizing a plurality of subscribers of a content delivery network and characterizing a plurality of advertisements that may possibly be inserted within an EPG. The subscribers and the advertisements are correlated to determine different advertisements that can be targeted to different subscribers. Targeted advertisements are selected to be inserted in the EPG based on said correlating. A plurality of targeted EPGs are created by inserting different targeted advertisements into advertisement opportunities within the EPG. The targeted EPGs are transmitted to the subscribers.

The Applicant submits that claim 50 is patentable over the combination of references relied on by the Examiner for the rejection of the previously pending claims for at least reasons similar to those advanced above. For example, even assuming *arguendo* that the references could be combine there is no combination of the cited references that disclose or suggest creating targeted EPGs, as recited in claim 50. Claims 51-53 depend from claim 50 and are therefore submitted to be patentable over the cited references for at least the reasons advanced with respect to claim 50 and for the further features recited therein. Applicant respectfully submits that claims 50-53 should proceed to allowance.

Newly added independent claim 50 is directed to a method for delivering targeted advertisements to subscribers of a content delivery network within an electronic program guide (EPG), the method includes creating a plurality of targeted EPGs, wherein each targeted EPG has different advertisements inserted within advertisement opportunities within an EPG and each targeted EPG has different characteristics associated with it. One or more subscribers of a content delivery network are characterized and the targeted EPGs and the subscribers are correlated to determine appropriate targeted EPG screens for the subscribers. The targeted EPGs are transmitted to the subscribers.

The Applicant submits that claim 54 is patentable over the combination of references relied on by the Examiner for the rejection of the previously pending claims for at least reasons similar to those advanced above. For example, even assuming *arguendo* that the references could

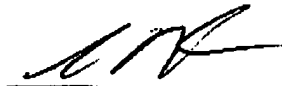
be combine there is no combination of the cited references that disclose or suggest correlating targeted EPGs and subscribers, as recited in claim 54. Claims 55-57 depend from claim 54 and are therefore submitted to be patentable over the cited references for at least the reasons advanced with respect to claim 54 and for the further features recited therein. Applicant respectfully submits that claims 55-57 should proceed to allowance.

Conclusion

For the foregoing reasons, Applicant respectfully submits that claims 1-57 are in condition for allowance. Accordingly, early allowance of claims 1-57 is earnestly solicited.

Should the Examiner believe that an Interview would help expedite prosecution of the application, the Examiner is requested to contact the undersigned attorney to schedule such an Interview.

Respectfully submitted,



Craig Hallacher
Reg. No. 54,896

Date: 9/21/2004

Technology, Patents & Licensing, Inc.
6206 Kellers Church Road
Pipersville, Pa 18947
phone: (215)766-2100 (x127)
fax: (215)766-2920